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09/825,470	04/02/2001	David Lawrence	17209-451	1341

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EXAMINER	
LONG, FONYA M	
ART UNIT	PAPER NUMBER
3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/825,470	LAWRENCE, DAVID	
	Examiner	Art Unit	
	FONYA LONG	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,6-9,11-20 and 24-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-9,11-20 and 24-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This communication is a Non-Final Office Action rejection on the merits in response to communications received on October 27, 2009. Claims 1, 14, 16, and 20 have been amended. Claim 28 has been added. Claims 3-5, 10, and 21-23 have been cancelled. Claims 1, 2, 6-9, 11-20, and 24-28 are currently pending and have been addressed below.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 6-9, 11-20, and 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following terms and concepts are not defined in a concrete manner that would allow someone to duplicate the invention. There are no clear and adequate explanations of the following terms so as to allow one wishing to duplicate and use the invention to do so:

Applicant has amended the claims language to read:

receiving, into the computer memory, information relating to a plurality of risk assessment factors associated with a legal action, wherein ***a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors and wherein*** the risk assessment factors are selected from a group consisting of a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion.

The claim language is then directed to:

assigning, by the computer, a user-defined weight to each of the plurality of risk assessment factors;

calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors;

calculating a risk quotient for the legal action by summing the plurality of risk factor values; and

in response to the calculated risk quotient, generating a suggested action associated with the legal action.

The specification explicitly states one exemplary way to implement the invention, which includes multiplying (an assigned numerical value representative of risk associated with a piece of information) x (a numerical weight of a risk assessment factor to which the information is assigned) and summing up the results for multiple pieces of information to obtain a risk quotient (scaled numerical or alphanumerical value).

How is the numerical value assigned to the risk assessment factors? What determines how the value gets assigned?

The calculation involves subjective analysis of values that are not defined. There is no detailed or concrete, full, concise and exact written description of how one would quantify or assign the values.

Applicant directs the Examiner to paragraphs 0045-0047 wherein it is discloses as follows:

[0045] A ALARM risk quotient can be calculated 313 by weighting the risk assessment factors 116 according to their relative risk, such as the likelihood of prolonged litigation, substantial damages, punitive actions, damaged public opinion or other adverse affects related to Risk. Calculating a ALARM risk quotient can be accomplished by assigning a numerical value to each risk assessment factor 116, wherein the numerical value is representative of the risk associated with a particular piece of information, or a combination of pieces of information. For example, it may be determined in one case that a litigation poses significant advantages with a very strong position that has a good chance of being resolved through a summary judgment before an issue friendly judge. Therefore this information from the first case is assigned a low numerical value, or even a negative numerical value. In a second case, an issue may involve subject matter that is sensitive politically or to public relations. Information conveying this type of subject matter with high risk may be assigned a high numerical value. In addition, a weight can be assigned to an ALARM risk assessment factor 116 to which the information is assigned. A Risk Quotient can be calculated by multiplying a weighted numerical value indicative of how important a risk assessment factor 116 may be in regards to Risk

times a value assigned according to the information contained in the risk assessment factor to obtain a risk factor value. The risk factor values may then be summed to obtain the Risk Quotient 110.

[0046] For example, information received may indicate a potential litigation would be before a court that has previously issued strong opinions adverse to a client's position. In addition, the subject matter of the potential litigation may be particularly sensitive in the political arena. The risk assessment factor 116 assigned to the court may be a numerical value of 8 indicating a high risk with a weight of 10 given to court positions. In addition, the subject matter may also be rated at an 8 because of the risk associated with the political climate and political climate may have a weight of 7 according to its location and breadth of coverage. On the other hand, the client may have strong evidence in support of their position, which may receive a 1 because it is a relatively low risk. Evidence may also have a risk factor value of 10. Also, the subject matter of the legal action may not be a core interest to the client wherein this risk factor may be assigned a value of 3, with interest to client having an assigned weight of 5. Therefore, the net score for this example would be 8 times 10 or 80 plus 8 times 7 or 56 plus 3 times 10 or 30 plus 3 times 5 or 15 for a sum of 181, which is the Risk Quotient.

[0047] A suggested action can be generated that is responsive to the Risk Quotient 314. For example, in response to a substantial risk indicated by a large value for a Risk Quotient, a suggested action may be to not proceed with a legal transaction or to settle a pending action. In response to a low risk score, the ALARM server 210 may respond by generating a course of action recommending pursuit of a legal action, and/or a strategy that may be executed to pursue the action. Intermediate scores may respond by suggesting that additional information be gathered, that various aspects of the legal action be monitored, or other interim measures.

There is no list of essential elements or questions identified which identify the numerical values and how they are assigned. Thus, there is no concrete result produced. The specification provides very little usable clear guidance as to how to objectively make the determination of what is produced in the report.

With respect to subjective information entered by a user, this subjective information would result in a different value depending on the scaled values that the individual, uses, how the values are assigned and the weight the individual assigns to a factor. Thus, for each individual performing the invention, the result would be different

and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention to the point where the users become the inventor of their own application of the invention, rather than the applicant.

Claims 16-20 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended the claim language to include the following limitation:

> **wherein the risk assessment factors are selected from a group consisting of: a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion.**

MPEP 2111.03 Transitional Phrases [R-3]

The transitional phrase "consisting of' excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948) ("consisting of' defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

The applicant discloses the following in the specification:

> [0045] A ALARM risk quotient can be calculated 313 by weighting the risk assessment factors 116 according to their relative risk, ***such as the likelihood of prolonged litigation, substantial damages, punitive actions, damaged public opinion or other adverse affects related to Risk.*** Calculating a ALARM

> risk quotient can be accomplished by assigning a numerical value to each risk assessment factor 116, wherein the numerical value is representative of the risk associated with a particular piece of information, or a combination of pieces of information. For example, it may be determined in one case that a litigation poses significant advantages with a very strong position that has a good chance of being resolved through a summary judgment before an issue friendly judge. Therefore this information from the first case is assigned a low numerical value, or even a negative numerical value. In a second case, an issue may involve subject matter that is sensitive politically or to public relations. Information conveying this type of subject matter with high risk may be assigned a high numerical value. In addition, a weight can be assigned to an ALARM risk assessment factor 116 to which the information is assigned. A Risk Quotient can be calculated by multiplying a weighted numerical value indicative of how important a risk assessment factor 116 may be in regards to Risk times a value assigned according to the information contained in the risk assessment factor to obtain a risk factor value. The risk factor values may then be summed to obtain the Risk Quotient 110.

The Examiner assets that specification does not provide support for the "consisting of" language.

The language in the specification is open ended, not closing the claim to inclusion of materials other than those recited. The specification identifies the listed factors as being a way of example. Furthermore, the language "or other adverse affects related to risk" indicates that the list comprises other factors.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 6-9, 11-20, and 24-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The claimed invention does not produce a concrete result. The invention as claimed is not repeatable and cannot be implemented without undue experimentation.

MPEP 2106 II A states as follows:

> A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant admits on page 10 of applicant's response filed on September 16, 2004 that the user of the present invention is free to generate a value via objective or ***subjective*** means. Applicant states on page 10 that:

> The present invention is not limited to any one method or algorithm for the generation of such a scaled value. Many techniques and methods can be adapted for the generation of a scaled value based upon the information relating to legal action. Applicant respectfully suggests that the present invention is not limited to any one algorithm or method for ascertaining the scaled numeric or alphanumeric value, and that generating such a person practicing the present invention is free to generate a value via objective or ***subjective*** means.

The applicant has not provided any objective means.

Applicant states on page 11 of the response submitted on July 7, 2005 that the "example on page 12, lines 15-27 specifically details that a risk assessment can be ***subjective*** to the client using the present invention, as can be a numerical value

representative of the risk associated with a particular piece of information." Applicant further states that a risk assessment factor can be anything that is important to the client and relates to the client's status as party to a litigation or an amicus curiae".

Many subjective interpretive criteria are involved in coming up with the end result in applicant's invention and it is not clear that the end result is predictive. The specification provides very little usable clear guidance as to how to objectively make the determination of how or what value is assigned or how or what weight is assigned to the risk assessment factors.

Thus, for each individual performing the invention, the scaled values would be different, the factors would be weighed differently and each individual performing the invention, for the same set of facts, would come up with a different result and the result would mean something different to each of the individuals.

The result of the instant invention is one or more numbers generated by a subjective analysis of a human being. Section 101 requires that the results be reproducible. In the instant case, the numerical values and the assigned weights are the result of expressions of subjective mental steps of a particular individual. Even the same person might generate different values and assign different weights, as when the person feels differently about the assessment factors at a different time. Moreover, since the result is subjective and dependent on a cognitive process, a person can be dishonest about how the values should be assigned or weighted. The subjective component of the invention is not amendable to reproducibility of a result. The result is not concrete or

tangible, but merely one or more numbers that may serve as input data for processing.

Thus, the applicant's invention is a process that consists solely of the manipulation of an abstract idea.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 6-9, 11-20, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al. (5,875,431) (hereinafter referred to as Heckman) in view of Halligan et al. (US 2002/0077941) (hereinafter referred to as Halligan).

Referring to Claims 1, 16, 20, and 28:

Heckman discloses a computer implemented method, system, and program code for managing risk related to a legal action, the system comprising a computer server (Figure2 (27) (28)) accessible with a network access device via a communications network (Figure 2 (20) and (19)) and software to cause the system to perform the method (col. 5, lines 11-17; col. 12, lines 40-54) comprising:

receiving, into a computer memory of the computer, information identifying a person's states as at least one of a party to a legal action and an amicus curiae of the court in a pending legal action; and receiving information relating to a plurality of risk

assessment factors associated with legal actions (col. 6, lines 45-64 a strategic legal service plan; requires identification of milestones against which one can measure process toward the objective; once this path has been identified, deviations destructive to progress are more detected and avoided; col. 7, lines 6-12 ***strategic case plans consist of an accurate assessment of a case's potential opportunities and weaknesses***; col. 7, lines 36-39 the legal team must decide upon the desired outcome ***and the acceptable level of risk or uncertainty permitted*** as it can affect the cost of delivery of services (risk assessment); col. 7, line 48 thru col. 8, line 4 perform a structured, or triage-type analysis to decide whether the case is defensible or meritorious; the results will usually be sufficient to permit a rough determination of exposure or liability; col. 16, lines 59-66 routing information to Risk Management); and

generating a suggested action (col. 5, lines 18-28 enabling an iterative, interactive closed loop legal strategic planning system ***to produce a legal strategic plan*** to maximize the likelihood of attaining the desired outcome to the case; col. 5, lines 61-67 strategic legal activity or litigation planning aspects of the invention involve defining the most cost-efficient process by which a defined, acceptable case outcome may be obtained) col. 13, lines 48-54; col. 14, lines 33-39 and 45-56; col. 17, lines 34-37).

Heckman does not disclose assigning a user-defined numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors, assigning a user-defined weight to each of the plurality of risk assessment

factors, calculating a risk factor value by multiplying the numerical value and the weight assigned to each of the risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk values.

However, Halligan discloses a trade secret documentation tool used to prepare reports and court exhibits documenting employee and outsider exposure to trade secrets so as to be used at the time of litigation by assigning a user-defined numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors *(Figure 4 Enter values of the five factors for the Trade Secret, page 2 [0020- 0023], page 6 [0094-0095], page 7 [0096] steps of applying a plurality of generally accepted legal criteria to the content of a trade secret,* ***assigning a value under each criterion****; applying generally accepted legal criteria (e.g. the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts; page 2 [0020-0023], page 6 [0095], and page 7 [0096-0098]* ***assigning a value under each criterion and generating one or more metrics from the assigned values; the applicant may provide information about the estimated values of the six factors of a trade secret, such as on a 1 to 5 scale****; assigning a value under each criterion and generating one or more metrics; Figures 3-4, 6 - Report Outliers, page 3 [0034] calculating the ratios and other logical and mathematical values from various values associated with the trade secret and other data and displaying and printing the results; page 7 [0096] comparing the results with predetermined threshold values may be used to provide and objective measure of whether the trade secret is defendable, (i.e.,*

defensible); used to establish that a court of competent jurisdiction would more likely than not find the existence of a trade secret.), assigning a weight to each of the plurality of risk assessment factors ([0009] using the six facts to document, weight and evaluate the existence of a trade secret and measures to protect the trade secret [0017] weighting of the six factors [0027] ***calculating various weightings of the six factors [0095] the five factors for each trade secret may be characterized by a value, a number on a scale of l to 5; the accounting system may calculate various weightings of the six factors)****, calculating a risk factor value by multiplying the numerical value and the weight assigned to each of the risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk values ([0034] calculating the ratios and other logical and mathematical values; [0097] assigned values may be averaged to provide the relevant metric; the six assigned values may be multiplied and the sixth root taken).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine analysis method and system of Halligan with the legal strategic analysis method and system of Heckman so that an evaluation can be performed to determine whether the trade secret is likely to meet the tests applied by the courts and comparing the results with predetermined threshold values which can be used to provide an objective measure of whether the trade secret is defendable, and thus any alleged misappropriation should be litigated if the defendability factors are high which may suggest a very important or defendable trade secret as opposed to trade secrets with low defendability factors.

Assuming the fact that the applicant has support in the specification for the "consisting of" language, the Examiner asserts that Heckman and Halligan disclose information relating to a plurality of risk assessment factors associated with legal actions (Heckman col. 6, lines 45-64 a strategic legal service plan; requires identification of milestones against which one can measure process toward the objective; once this path has been identified, deviations destructive to progress are more detected and avoided; col. 7, lines 6-12 ***strategic case plans consist plan accurate assessment of a case's potential opportunities and weaknesses***; col. 7, lines 36-39 the legal team must decide upon the desired outcome and ***the acceptable level of risk or uncertainty permitted*** as it can affect the cost of delivery of services (risk assessment); col. 7, line 48 thru col. 8, line 4 perform a structured, or triage-type analysis to decide whether the case is defensible or meritorious; the results will usually be sufficient to permit a rough determination of exposure or liability; col 16, lines 59-66 routing information to Risk Management)

> The fact that the risk assessment factors are selected from a group consisting of a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion further defines the factors and is determined to be nonfunctional descriptive data which is not functionally involved in the steps recited. The steps to the invention would be performed the same regardless of what type risk factors are being assessed. The structure of the system would be the same. Thus, this descriptive material will not distinguish the claimed invention form the prior art in terms of patentability, see In re Gulack, 703 f. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); in re Lowry, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Referring to Claim 2:

Heckman disclose generating a report including the suggested action *(col 5, lines 64-67 defining the most cost-efficient process by which a defined, acceptable case outcome may be obtained, col. 6, lines 13-17provides the "best" legal strategic plan to achieve a desired out is enhanced as completed cases are analyzed, lines 45-48, col. 19-BESTMODE, Figure 5-1 (62)* Figure 5-2 (68, 69) col. 13, lines 48-54 reporting information; col. 14, lines 33-39 and 45-56 (track and report; quality or type of reports; col. 17, lines 34-37)).

Referring to Claim 6:

Both Halligan and Heckman disclose wherein the suggested action is directed towards reducing risk related to a legal action *(Halligan -page 1 [0009] an evaluation should be done to determine whether the trade secret is likely to meet the tests applied by the courts; Section 757 of the First Restatement of Torts sets forth six factors for evaluating the existence of a trade secret to assist courts in adjudicating trade secrets, page 2 [0020], page 7 [0096-0098] defendability factors may suggest a very important or defendable trade secret; and Heckman - col. 6, lines 9-23 provides "best" legal strategic plan to achieve a desired outcome).*

Referring to Claims 7-9:

Heckman discloses a strategic planning method and system with the ability to provide the "best" legal strategic plan (col. 6, lines 8-23, 45-64) which could encompass arbitration. Heckman discloses wherein the suggested action comprises commencing a litigation and wherein the suggested action comprises settling a legal action *(Figure 4*

col. 22, lines 12-28 based on the results of the preliminary analysis, a decision is made to either go forward with legal action or stop and settle the case).

Referring to Claim 11:

Heckman discloses wherein at least one of the plurality of risk assessment factors is associated with a venue for the legal action *(col. 8, lines 21-36 Venue, col. 16, lines 59-60 impact of the venue of the case, the relevant jurisdiction, col. 15, lines 21-22, Figure 2).*

Referring to Claim 12:

Halligan discloses wherein the received information relating to the plurality of risk assessment factors is gathered electronically (Figure 1, [0051-0061] [0080]).

Referring to Claim 13:

Both Heckman and Halligan disclose a method further comprising aggregating scaled numerical or alphanumerical values relating to the person *(Heckman – defendants col. 8, lines 38-63 and Halligan - trade secrets)* and assessing an aggregate level or risk related to actions *(Heckman Figures 1-2, 3 (33 case specific data) (34, 35, 37, 38), Figure 4, legal and factual issues, nature of case, Figures 5-1 and 5-2; col. 7, lines 36-40 acceptable level of risk and uncertainty; col. 8, lines 5-20 summary of case facts, lines 37-52 Current Case Development; col 11, lines 18-41; col. 20, line 67 thru col. 21, line 2 the risk of not achieving the desired outcome is a factor in selecting the baseline template; minimizing the risk of failure for each task; Halligan page 2-3 [0020-0034]; page 7 [0099] risk of loss of the trade secret).*

Referring to Claim 14:

Halligan discloses calculating an average numeric value or value associated with the person (page 5 [0084] Table B, Figure 5 Calculate Employee Risk Factor; page 8 [0105-0106]).

Referring to Claim 15:

Heckman discloses a legal action with litigation (Figure 4). Heckman does not disclose that the legal action is a class action suit.

The fact that the legal action is a class action suit is determined to be nonfunctional descriptive data which is not functionally involved in the steps recited. The steps to the invention would be performed the same regardless of this data. Thus, this descriptive material will not distinguish the claimed invention form the prior art in terms of patentability, see *In re Gulack*, 703 f. 2d. 1381, 1385, 217 USPQ 401,404 (Fed Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the, time of the invention to incorporate this data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Referring to Claims 17-19:

Halligan discloses wherein the information is received via an electronic feed, wherein the network access device is a personal computer, or a wireless handheld device (Pages 3-4 [0052-0066]).

Referring to Claims 24-27:

The fact that the person is a legal person or a natural person, or a combination of both or that the legal person is governmental entity, or that the suggested action comprises appearing as an amicus curiae of the court in litigation, or that the risk comprises legal, regulatory, financial and reputational exposure is determined to be nonfunctional descriptive data which is not functionally involved in the steps recited. The steps to the invention would be performed the same regardless of this data. Thus, this descriptive material will not distinguish the claimed invention form the prior art in terms of patentability, see *In re Gulack*, 703 f. 2d. 1381, 1385, 217 USPQ 401,404 (Fed Cir. 1983); *In re Lowry*, 32F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Response to Arguments

7. Applicant's arguments filed October 27, 2009 have been fully considered but they are not persuasive.

With regards to Applicant's arguments regarding the 101 rejections, Examiner respectfully disagrees. Examiner asserts that Claims 1, 2, 6-9, 11-20, and 24-27 fail to produce a concrete result. The invention as claimed is not repeatable and cannot be implemented without undue experimentation.

MPEP 2106 II A states as follows:

> A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant admits on page 10 of applicant's response filed on September 16, 2004 that the user of the present invention is free to generate a value via objective or ***subjective*** means. Applicant states on page 10 that:

> The present invention is not limited to any one method or algorithm for the generation of such a scaled value. Many techniques and methods can be adapted for the generation of a scaled value based upon the information relating to legal action. Applicant respectfully suggests that the present invention is not limited to any one algorithm or method for ascertaining the scaled numeric or alphanumeric value, and that generating such a person practicing the present invention is free to generate a value via objective or ***subjective*** means.

The applicant has not provided any objective means.

Applicant states on page 11 of the response submitted on July 7, 2005 that the "example on page 12, lines 15-27 specifically details that a risk assessment can be ***subjective*** to the client using the present invention, as can be a numerical value representative of the risk associated with a particular piece of information." Applicant further states that a risk assessment factor can be anything that is important to the client and relates to the client's status as party to a litigation or an amicus curiae".

Many subjective interpretive criteria are involved in coming up with the end result in applicant's invention and it is not clear that the end result is predictive. The specification provides very little usable clear guidance as to how to objectively make the determination of how or what value is assigned or how or what weight is assigned to the risk assessment factors. The specification fails to provide in criteria for how to assign

and value and how to assign a weight in order to provide standardized process to the user when providing a value and a weight.

Thus, for each individual performing the invention, the scaled values would be different, the factors would be weighed differently and each individual performing the invention, for the same set of facts, would come up with a different result and the result would mean something different to each of the individuals.

With regards to Applicant's arguments pertaining to the 112 1st rejections, Examiner respectfully disagrees. The calculation involves subjective analysis of values that are not defined. There is no detailed or concrete, full, concise and exact written description of how one would quantify or assign the values.

There is no list of essential elements or questions identified which identify the numerical values and how they are assigned. Thus, there is no concrete result produced. The specification provides very little usable clear guidance as to how to objectively make the determination of what is produced in the report.

With respect to subjective information entered by a user, this subjective information would result in a different value depending on the scaled values that the individual, uses, how the values are assigned and the weight the individual assigns to a factor. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention to the

point where the users become the inventor of their own application of the invention, rather than the applicant.

With regards to Applicant arguments regarding the 103 rejections in view of Heckman et al. and Halligan et al., Examiner respectfully disagrees. Applicant asserts that Halligan "discusses its method with respect to the protectability of trade secrets and not a legal action." As a result, Applicant asserts that the Heckman et al. and Halligan et al. combination still fails to discloses "... information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors…" Examiner asserts Halligan discloses in paragraph [0009] that in addition to collecting information on the company's trade secrets, and evaluation should be done to determine whether the trade secret is likely to meet the tests applied by the courts. In the United States, Section 757 of the First Restatement of Torts set forth six factors for evaluating the existence of a trade secret to assist the courts in adjudicating trade secret cases. One of the inventions they claim is a method of using the six factors to document, weigh, and evaluate the existence of a trade secret and measures to protect the trade secret. Thus, the Examiner asserts that Halligan is concerned with the protectability of a legal action and with managing and assessing risks associated with legal actions. Examiner also asserts that Halligan et al. discloses information relating to a plurality of risk assessment factors associated with a legal action ([0009] discloses a plurality of factors associated which are applied by the

courts in trade secret cases (i.e. legal action)), wherein the numerical value is assigned to each of the plurality of risk assessment factors ([0021; 0027-0035] discloses assigning a value for the six factors of the trade secret).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Heckman et al. is directed to the concept of legal planning for a plurality of legal fields. Halligan et al. discloses concept of developing proof of the existence of trade secrets that will aid in legal actions pertaining to allegations of theft or misappropriation of trade secrets ([0005-0009]). Therefore, Examiner asserts it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Heckman et al. to include the invention of Halligan et al. in order to aid in the planning and preparation of a legal action pertaining to a theft or misappropriation of trade secrets; and determining the risks associated with the trade secrets and planning measures to protect to trade secrets in order to aid in avoiding legal actions.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689